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PTO/SB/33 (07-05)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>5577-321</b>	
I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office  on <u>May 29, 2007</u>  Signature <u></u>  Typed or printed name <u>Amelia Tauchen</u>		Application Number <b>09/782,772</b>	Filed <b>02/13/2001</b>
		First Named Inventor <b>Renee M. Kovales</b>	
		Art Unit <b>2614</b>	Examiner <b>Joseph T. Phan</b>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

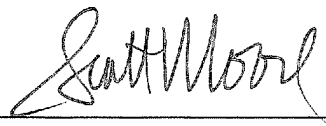
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ attorney or agent of record. **42,011**  
Registration number \_\_\_\_\_
- ☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
\_\_\_\_\_  
Signature  
**D. Scott Moore**  
\_\_\_\_\_  
Typed or printed name  
**919-854-1400**  
\_\_\_\_\_  
Telephone number  
**May 29, 2007**  
\_\_\_\_\_  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE UNDER 37 C.F.R. 1.116  
EXPEDITED PROCEDURE EXAMINING GROUP 2614**

Attorney Docket No. RSW920000127US1 (5577-321)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Kovales et al.

Serial No.: 09/782,772

Filed: February 13, 2001

For: RECORDING AND RECEIVING VOICEMAIL WITH FREEFORM BOOKMARKS

Confirmation No.: 2011

Examiner: Joseph T. Phan

Group Art Unit: 2614

Date: May 29, 2007

Mail Stop AF

Commissioner for Patents

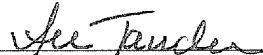
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**CERTIFICATION OF TRANSMISSION**

**UNDER 37 CFR § 1.8**

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Amelia Tauchen

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL  
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to IBM's Deposit Account No. 09-0461.

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed January 26, 2007 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Applicants respectfully submit that many of the recitations of the pending claims are not met by the cited references for at least the reasons discussed herein and in Applicants' previously filed Request For Reconsideration of November 8, 2006. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of independent Claims 1, 33, and 57, and dependent Claims 13, 45, and 70.

**Independent Claims 1, 33, and 57 Are Patentable**

Independent Claims 1, 33, and 57 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 5,943,402 to Hamel et al. (hereinafter "Hamel") in view of U. S. Patent No. 6,442,243 to Valco (hereinafter "Valco"). (Final Action, page 2). Independent Claims 1, 33, and 57 are directed to a method, a system, and a computer program product, respectively. For example, independent Claim 1 recites:

providing at least one bookmark for a voice mail message by a caller leaving the voice mail message;  
wherein at least one bookmark is used to mark one or more segments of the voice mail message as having one or more different degrees of importance.

Claims 33 and 57 include similar recitations. Thus, according to the independent claims, a caller leaving a voice mail message may provide one or more bookmarks of which at least one of the bookmark(s) is used to mark one or more segments of the voice mail message according to degree(s) of importance.

The Final Action acknowledges the Hamel does not disclose bookmarked segments having one or more different degrees of importance, but alleges that Valco provides the missing teachings. (Final Action, page 2). The Final Action cites the passage at column 12, lines 55 through 59 of Valco as disclosing that a caller may record a voice mail message and mark the message as urgent or private. (Final Action, page 2). The pending independent claims, however, describe marking one or more segments of a voice mail message as having one or more different degrees of importance. According to Merriam-Webster's Dictionary, 11<sup>th</sup> Edition, a segment is defined as "a separate piece of something." Thus, the pending independent claims describe

marking one or more separate pieces of a voice mail message as having one or more different degrees of importance. Valco, by contrast, describes marking an entire voice mail message as urgent or private. Applicants can find no disclosure or suggestion in Valco with respect to marking one or more segments or separate pieces of a voice mail message as urgent or private.

In response to this argument, the Final Action acknowledges that Valco does not disclose or suggest marking specific segments of a voice mail message as having different degrees of importance, but cites Valco merely for the proposition that a file can be marked as important or not. (Final Action, page 18). Applicants submit, however, that the combination of Hamel and Valco does not teach the recitations of the pending independent claims as alleged in the Final Action, rather the combined teachings of Hamel and Valco merely teach that a voice message may be partitioned into segments using audible interrupts (Hamel, Abstract) and the entire voice message may be marked as urgent or private. (Valco. col. 12, lines 55 – 59).

Independent Claims 1, 33, and 57 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of U. S. Patent No. 6,832,350 to Bates et al. (hereinafter "Bates"). (Final Action, page 10).

The Final Action acknowledges that Hamel does not disclose that the bookmarked segments have one or more different degrees of importance, but alleges that Bates provides the missing teachings. (Final Action, page 11). Applicants respectfully disagree with this interpretation of Bates. In sharp contrast with the recitations of the pending independent claims in which the bookmarks are used to mark segments of a voice mail message, the bookmarks described in Bates are used to identify Uniform Resource Locators (URLs) for locations of information on the World Wide Web. (Bates, col. 1, lines 59 – 67). Thus, the bookmarks described in Bates have nothing to do with dividing up a file, such as a voice mail message, into segments and marking those segments as having one or more different degrees of importance. Instead, the bookmarks described in Bates are merely shortcuts to sites on the World Wide Web.

In response to this argument, the Final Action cites the paragraph at col. 2, lines 1 – 6 of Bates as disclosing the use of bookmarks to mark a file as important or not. (Final Action, page 19). Applicants submit that this is a mischaracterization of the teachings of Bates. The paragraph at col. 2, lines 1 – 6 of Bates merely warns that a user of an Internet browser should take care not to add too many URLs to his/her bookmarks or favorites as a large number of

bookmarks or favorites may make it difficult for the user to remember which URLs are his/her most important sites. Bates does not suggest that the individual bookmark or favorite identify a portion or segment of a file as more or less important.

Therefore, Applicants respectfully request that the present application be reviewed and the rejection of independent Claims 1, 33, and 57 be reversed by the appeal conference prior to the filing of an appeal brief.

#### **Various Dependent Claims are Separately Patentable**

Dependent Claims 2 - 4, 6 - 32, 34 - 42, 44 - 56, and 58, 59, and 61 - 91 are patentable at least as they depend from patentable independent Claims 1, 33, and 57. Applicants further submit, however, that various dependent claims are separately patentable for at least the reasons discussed hereafter.

Dependent Claims 13, 45, and 70 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Valco and also in view of Hamel in view of Bates (Final Action, pages 2 and 10). The Final Action does not address the recitations of these Applicants respectfully submit that neither Hamel, nor Valco, nor Bates appear to contain any disclosure with respect to using labels or markers to mark a segment of a voice mail message as protected or confidential. The Final Action refers to the disclosure in Valco (col. 12, lines 4 – 7 and 55 – 59) that describes the ability to mark an entire voice message as private (Final Action, page 5), but Applicants submit that the combination of Hamel and Valco contains no disclosure or suggestion of marking only a segment of a voice mail message as private. With respect to the rejection based on the combination of Hamel and Bates, this appears to be in error as the Final Action cites to col. 12, lines 4 – 7 and 55 – 59 of Bates, which is the same column and line numbers used to refer to Valco.

In re: Kovales et al.  
Serial No.: 09/782,772  
Filed: February 13, 2001  
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Accordingly, for at least the additional reasons discussed above, the cited references do not disclose or suggest the recitations of dependent Claims 13, 45, and 70. Therefore, Applicants respectfully request that the present application be reviewed and the rejection of dependent Claims 13, 45, and 70 be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. Scott Moore". The signature is fluid and cursive, with the first name "D." and last name "Moore" clearly distinguishable.

D. Scott Moore  
Registration No. 42,011

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